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OFFICE OF PETITIONS

In re Application of :
Yousseff :
Application No. 09/276,021 : UNDER 37 CFR 1.47(b)
Filed: March 25, 1999 :
Atty. Dkt. No.: 024/1 :
For: RAPID TRAINING ECHO :
CANCELLOR FOR :
TELECOMMUNICATIONS SYSTEM

This decision is in response to the petition under 37 CFR 1.47(b), filed September 7, 1999.

The petition is DISMISSED.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed March 25, 1999 without an executed oath or declaration. Accordingly, a Notice to File Missing Parts of Nonprovisional Application ("Notice") was mailed April 29, 1999 requiring an executed oath or declaration and a surcharge.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) a showing that such action is required to preserve the rights of the parties or to prevent irreparable damages.

The instant petition fails to satisfy items (1), (2), (4), and (6) set forth above.

As to item (1), petitioner has failed to establish that the non-signing inventor has refused to execute the oath or declaration after having been presented with the complete application papers (specification including claims, drawings, and oath or declaration) or cannot be located for presentation of the application papers.

The instant petition fails to set forth if petitioner alleges the non-signing inventor has refused to execute the oath or declaration after having been presented with a complete copy of the application papers or if petitioner alleges the non-signing inventor cannot be located for presentation of the application papers.

There is no evidence to establish the non-signing inventor received a complete copy of the application papers and thereafter refused to executed the oath or declaration.

Before a refusal to sign an oath or declaration can be alleged, it must be demonstrated that a *bona fide* effort has been made to present a complete copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor at the non-signing inventor's last known address, typically a residential address.

Any renewed petition must establish that the non-signing inventor was presented with a complete copy of the application papers and thereafter refused to execute the oath or declaration.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.

Any renewed petition should be accompanied by evidence to establish that the non-signing inventor was sent a complete copy of the application papers (specification, claims, drawings, and oath or declaration) and thereafter refused to execute the declaration. Petitioner may wish to provide the Office copies of letters sent to the inventor indicating the enclosure of the application papers (specification, claims, drawings, and oath or declaration). If after the inventor receives the application papers and requests to execute the oath or declaration are refused, these facts should be set forth in a statement of facts signed by the person to whom the refusals were made and detailing with specificity the exact manner of the refusals. If a written refusal has been made, a copy of the written refusal should be included on renewed petition. Petitioner's attention is directed to MPEP 409.03(d) for further guidance.

Petitioner has failed to establish the non-signing inventor cannot be reached or located.

Petitioner is reminded that before it is alleged that an inventor cannot be reached or located, petitioner is required to demonstrate that diligent effort has been exerted to locate the non-signing inventor for presentation of a complete copy of the application papers (specification, including claims, drawings, and oath or declaration).

Petitioner has failed to establish that diligent effort has been made to locate the inventor.

Any renewed petition must be supported by evidence that sufficiently establishes that despite diligent effort, the non-signing inventor cannot be located. A statement of facts should be submitted that fully describes the exact facts that are relied on to establish that a diligent effort was made to locate the non-signing inventor. The statement of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay, will not normally be accepted. At the very least, a search of the internet, human resource records, telephone directories, etc. should be undertaken in regions where it is suspected the non-signing inventors may reside. Petitioner should reference and supply evidence of any such searches in a renewed petition. See, MPEP 409.03(d).

As to item (2), the petition is not accompanied by an oath or declaration properly executed on behalf of the non-signing inventor. The declaration is unacceptable as it fails to identify

the inventor by name, residence, mailing address, and citizenship. Correction is required. The declaration should be executed by a corporate officer, such as the president, vice president, secretary, or treasurer of the assignee on behalf of and as agent for the non-signing inventor. The corporate officer's title or position must be identified in the declaration. If an officer is unavailable to execute the declaration, the declaration may be signed on behalf of the corporation by one whose proof of signing authority has been submitted to the Office, such as the corporation's attorney. The signature block of the non-signing inventor should remain unexecuted. See, MPEP 409.03(b).

As to item (6), petitioner has failed to present a showing that action under 37 CFR 1.47 is required to preserve the rights of the parties or to prevent irreparable damages. Irreparable damage may be established by a showing in the form of a statement that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300

By hand: U.S. Patent and Trademark Office
Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3205.



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